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APPLICATION NO.	FI	LING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,520	053,520 01/17/2002		James E. Rothman	11746/46004	3143
26646	7590	10/06/2004		EXAMINER	
KENYON		ON	BASI, NIRMAL SINGH		
ONE BROA NEW YORK		0004	ART UNIT	PAPER NUMBER	
	,		1646		
				DATE MAIL ED. 10/06/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
		10/053,520	ROTHMAN ET AL.
	Office Action Summary	Examiner	Art Unit
		Nirmal S. Basi	1646
Period fo	The MAILING DATE of this communication ap or Reply	pears on the cover sheet with the c	orrespondence address
A SH THE - Exte after - If the - If NO - Failu Any	ORTENED STATUTORY PERIOD FOR REPL MAILING DATE OF THIS COMMUNICATION. nsions of time may be available under the provisions of 37 CFR 1. SIX (6) MONTHS from the mailing date of this communication. period for reply specified above is less than thirty (30) days, a repl operiod for reply is specified above, the maximum statutory period period for reply within the set or extended period for reply will, by statute to reply within the set or extended period for reply will, by statute reply received by the Office later than three months after the mailined patent term adjustment. See 37 CFR 1.704(b).		nely filed s will be considered timely. the mailing date of this communication.
Status			
2a)[Responsive to communication(s) filed on 01 (This action is FINAL . 2b) This Since this application is in condition for allowed closed in accordance with the practice under	s action is non-final. ance except for formal matters, pro	
Dispositi	on of Claims		
5) 6) 7)	Claim(s) <u>1-30</u> is/are pending in the application 4a) Of the above claim(s) is/are withdra Claim(s) is/are allowed. Claim(s) is/are rejected. Claim(s) is/are objected to. Claim(s) <u>1-30</u> are subject to restriction and/or	wn from consideration.	
Applicati	on Papers		
10) 🗌	The specification is objected to by the Examina The drawing(s) filed on is/are: a) acc Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct The oath or declaration is objected to by the Ex	cepted or b) objected to by the Education of the Education of the drawing(s) be held in abeyance. See the drawing(s) is objection is required if the drawing(s) is objection is required.	e 37 CFR 1.85(a). ected to. See 37 CFR 1.121(d).
Priority u	nder 35 U.S.C. § 119		
a)[Acknowledgment is made of a claim for foreign All b) Some * c) None of: 1. Certified copies of the priority document 2. Certified copies of the priority document 3. Copies of the certified copies of the priority document application from the International Burea ee the attached detailed Office action for a list	ts have been received. Is have been received in Application It documents have been receive It (PCT Rule 17.2(a)).	on No d in this National Stage
Attachment	(s)		
1) Notice 2) Notice 3) Inform	e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-948) nation Disclosure Statement(s) (PTO-1449 or PTO/SB/08) No(s)/Mail Date	4) Interview Summary (Paper No(s)/Mail Dat 5) Notice of Informal Pa 6) Other:	e

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DETAILED ACTION

1. Amendments filed 1/17/02, 10/1/02 have been entered

2. Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1-13, drawn to a method of identifying a peptide which binds heat shock protein comprising contacting with a phage display library, classified in class 435, subclass 6, for example
- II. Claims 14-15 and 19-27 drawn to conjugate peptide comprising a tether and an antigenic peptide, classified in class 514, subclass 2.
- III. Claims 16-18 and 28-30, drawn to a method of inducing an immune response in a subject comprising administering conjugate peptide comprising a tether and an antigenic peptide, classified in class 424, subclass 9.34, for example.

The inventions are distinct, each from the other because of the following reasons:

The products of Inventions II and the methods of Inventions III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products of Invention II can be used to raise antibodies in rabbits, and said antibodies can be further used to isolate and purify its cognate protein.

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The products of Invention II are distinct from the method of Invention I wherein the products of Invention I can neither be used in nor made by the methods of Invention I.

The methods of Inventions I and III are distinct because they are independent, using separate method steps, active agents and having different effects. The method of invention identify a peptide which binds to a heat shock protein whereas the method of invention III induces an immune response.

A search of the art for Inventions I-III would not be co-extensive with each other. Because the searches required for these inventions are not co-extensive an examination of the materially different, patentably distinct inventions in a single application would constitute a serious burden on the examiner. The inventions have a separate status in the art as shown by their different classifications.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for each group is not required for the other groups because each group requires a different non-patent literature search due to each group comprising different products and/or method steps, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final

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rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal S. Basi whose telephone number is 571-272-0868. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda G Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nirmal S. Basi Art Unit 1646 September 29, 2004 BRENDA BRUMBACK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600